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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/509,803

09/30/2004

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A20-068

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28156 7590 03/09/2009
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EXAMINER

PRATT, HELEN F

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|------------------------------------------|--|
| Office Action Summary | Application No. 10/509,803 | Applicant(s) KAEHNE, IAN DAVID | |
| | Examiner Helen F. Pratt | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 1-42, 47-48, 55-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. No basis is seen for the amendment to claim 1 of 12-12-08. In particularly, no basis is seen for "substantially free of a flavor or sweetener compound". These ingredients are said to be added in paragraphs 0058 and 0059. In addition limitations a – h are considered to be relative limitations, without anything to judge them against. The terms "too weak or too strong, or a palate balance or too acidic or too alkali, or limitations 5-7" in claim 1 are relative terms which renders the claim indefinite. The terms as above" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 8- 42, 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A survey on the composition of mineral water and identification of natural mineral water" (Luk) in view of Someya and Tuffley (WO02/00043), Lindon (4,325,975), and Mehansho et al. (7,090,878) and Dyrr et al. (WO 01/52672).

The article "A survey on the composition of mineral water and identification of natural mineral water "(Luk) discloses the comparison of sixty mineral water samples from different sources (abstract). The water can contain the addition of minerals, page 309, 1st para., line 13. The reference discloses all of the required minerals in various amounts. The minerals in groups 3 and 4 are not actually required by the language of claim 1 since zero amounts are listed. The reference to Luk discloses amounts in group 1 and b at within the claimed amounts except for phosphorous (p 311). Claim 1 differs from the reference in the use of phosphorous in the mineral waters. However, Someya discloses that it is known to make a beverage from coral sand, which contains phosphorous (Table 1, 6th item). Also, the other minerals are disclosed by Someya.

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Tuffley discloses a beverage which contains a supplement of minerals in particular amounts of 50 Mg/l of calcium, 45 mg of phosphorous, and manganese glycinate, magnesium glycinate in amounts of from 75 mg. and in amounts of 2.5 mg/l, magnesium in amounts of 5 mg (page 9). Mehansho et al. disclose a mineral fortified water composition containing calcium, iron, zinc, copper, manganese iodine, magnesium (abstract). Lindon discloses a mineralized drinking water continuing strontium, magnesium, calcium and lithium (abstract). The particular amounts are seen as being within the skill of the ordinary worker. Dyrr et al. disclose that 37 elements can be found in water and 24 are essential for proper nutrition and health (page 7, lines 10-30). The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a water product containing minerals, properties such as taste and nutrition are important. It appears that the precise ingredients as well as their proportions affect the taste and nutrition of the product, and thus are result effective variables, which one of ordinary skill in the art would routinely optimize.

As to the other minerals, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no

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one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Each ingredient is used for its known function. Nothing has been shown as to a coaction of ingredients that produce anything new or unexpected. Adding particular amounts of ingredients to make a beverage taste good is within the skill of the ordinary worker as this is a method of trial and error. Therefore, it would have been obvious to make a beverage containing known minerals in particular amounts as shown by the combined references.

Claim 1 has been amended to making a beverage which does not have any flavor or sweetener compound. However, as above, no basis is seen for this limitation. In addition, it would have been within the skill of the ordinary worker to add such depending on the particular composition. Various mineral waters are well known, that do not contain flavors or sweeteners. Claim 1 also contains limitations a-h which have no basis in the specification. Applicants affidavit has been noted. However, it compares the claimed product to other mineral waters, and not to the closest prior art. In addition, the added limitations are relative, and it is not known exactly how much of each element is required. Therefore, the limitations cannot be compared to the prior art. It is seen that the combined references disclose such a product absent a showing to the contrary. Therefore, it would have been obvious to add or not add sweeteners or flavor,

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and to formulate a composition which taste acceptable as shown by the combined references.

Claim 2 further requires a particular pH for still water, aerated or carbonated water. The pH of pure water is 7. Claim 41 requires that the water is still water with a pH of 7.2 to 7.6. The reference to Mehansho et al. disclose the use of a fortified water with minerals to be between 4 and 9.5. Ph's of course can easily be adjusted with acids and bases. Therefore, it would have been obvious to adjust the ph to a required level.

Claims 2 and 42 further require the addition of carbon dioxide. The addition of carbon dioxide to water is old and nothing new is seen in bubbly water. Therefore, it would have been obvious to add a known gas to water for its known function.

Claims 3, 4, 8-12 further require particular concentration of minerals, and claims 13-40 that the minerals come from particular sources. However, these sources are well known and nothing new is seen in their use. It would have been within the skill of the ordinary worker to use food safe sources of minerals. Applicants have not made any claim that they have discovered these particular sources of minerals. Therefore, it would have been obvious to use known food safe sources of minerals to make the claimed composition.

Claims 47-48 further require making concentrated preparations of the various groups and adding them to water in particular amounts. However, method limitations are not given weight in a composition claim. Nothing new is seen in the concentration of water which merely requires boiling away particular amounts of water or the use of less water. Certainly, the use of concentrated solutions is more feasible, than large

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quantities of water. Therefore, it would have been obvious to make concentrated solutions of minerals.

Claims 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above combined references as applied to claims 1- 4, 8-52 above, and further in view of Jakubowicz (DE19700368).

Claims 55 and 56 further require adding the claimed mineral water to a beverage in particular amounts or to use a concentrate of the mineral water. However, dilution of beverages is very well known as in diluting a concentrate such as orange juice or dried beverage compositions. Jakubowicz discloses adding a concentrated divalent ion salt/citric acid mixture solution to drink ingredients. The particular concentration is seen to have been within the skill of the ordinary worker. Therefore, it would have been obvious to add concentrated mineral solutions to dilute beverages to any concentration.

Nothing new is seen as in claim 58 of adding concentrated mineral waters to dilute a beverage, as the beverage will be diluted no matter the type of water. As above it is known to mineralize water. Nothing new is concentrating a mineral solution. Therefore, it would have been obvious to dilute a beverage as in claims 58 and 59.

Claims 60 and 61 further require diluting beer and other alcoholic beverages and tea. Mehansho et al. disclose that it is known to flavor water with botanic flavors and tea and hops. No patentable distinction is seen in flavoring water or in diluting a flavorant. Therefore, it would have been obvious to dilute a flavored beverage with water.

Allowable subject matter

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Claims 5, 6, 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 5, 6, and 7 all need to be added to claim 1.

ARGUMENTS

Applicant's arguments filed 2-6-09 have been fully considered but they are not persuasive. Applicants argue that the Declaration of Neil Paulett gives evidence of patentability. This is not seen as it did not compare the instant claims to the cited prior art.

As above, applicants do not have basis for the exclusion of flavors or sweeteners.

Applicants argue that known of the references disclose balancing the minerals to make a tasty mineral water. However, as applicant is only using 7 known minerals in particular amounts, as in In re Boesch, it would have been obvious to vary the amounts to make a good tasting composition.

Certainly, the taste of each mineral impacts other minerals. Applicant does not have many minerals, but 7, as the rest can be used in zero amounts.

The Examiner has asserted that varying the concentrations of elements C and D is within the skill of the ordinary worker. Also, C and D contain lower levels of zero amounts.

Applicants argue that it is not known to balance two or more elements to achieve a taste balance. However, this is what is generally done in making a food product, and particularly in the use of acids, which balance the alkaline taste of some minerals.

As to the various amounts in comparing notes to examples, that various elements vary. Certainly, this is so, but this is expected and therefor, obvious.

When the Examiner states that nothing is shown that phosphorous affects the taste of the product. However, this reference is combined with other references to show that it is known to add phosphous to mineral waters.

It is not that it doesn't matter about the various amounts, but that it is within the skill of the ordinary worker to determine the particular amounts of ingredients, as in *In re Boesch*, above. Just as in making any recipe, the particular amounts are determined by how the product taste, and absent anything unobvious, or a coaction of ingredients (*In re Levin*), it would have been obvious to add particular amounts of ingredients to make a good tasting product.

As to the 8 part taste requirement, now in the claims, no basis is seen for that language, per se, plus the limitations are relative as above.

Applicants argue that as minerals are known to impart an unpleasant taste and that *Tuffley* and *Mehansho* teach that particular amounts of minerals can taste unpleasant, and that a flavoring agent is added to mask the taste. However, applicants are trying to duplicate a natural mineral water, and not one which has enough minerals to meet the United States Dept. of Agriculture nutrition tables recommended allowances per day as in *Mehansho* '878. Also, *Mehansho* discloses that a flavoring

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agent can optionally be used, and is needed to mask the metallic taste of iron.

However, applicants do not require the use of iron, as in group D. Also, Mehansho discloses that mineral compounds can be admixed at the desired nutrient level (col. 12, lines 59-61). This would could require some flavoring, but if some of the minerals as in group C are listed as being in zero amounts there would be no need of flavoring.

These references are combined with Luk as the primary reference to show that mineralized drinking water is well known, and only one mineral is not found in the claimed range. Other references are used to show that that amount of phosphorous is known. Nothing is shown that using phosphorous in particular amounts affects the taste of the composition.

Applicants argue that the claims are to a balance of elements which can result in a good tasting beverage. However, the minerals are all known and are known to be used in the claimed amounts except for phosphorous. Certainly, nothing inventive is seen in adding a little more of one mineral and a little more of another , especially when minute amounts are used which are not considered to be nutritionally supplemental, as in the RDA's.

Applicants argue that there is no reason to combine Luk and Someya. As above, it would have been within the ordinary skill to vary the amounts of elements. Seven elements to vary is not that much. Just as in adding salt, sugar and flavorings to liquids, the amounts can be varied to provide the right balance of taste.

In addition the goal of making a good taking manufactured mineral water, is not stated in the claims, and is at best a nebulous standard.

It is seen that it is obvious to add known mineral elements to beverages.

Phosphorous is a ubiquitous element found everywhere, particularly in soft drinks.

The reference to Jakubowicz is used for what was cited in the last office action in that it is known to adjust the pH of beverages with organic acids.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 571-272-1404. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Keith Hendricks can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Helen F. Pratt/

Primary Examiner, Art Unit 1794

Hp 3-5-09